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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,945	03/21/2001	Said Sebt	USF-T141X	1290

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Jeff Lloyd, Esq.
Saliwanchik, Lloyd & Saliwanchik
2421 N.W. 41 st Street, Suite A-1
Gainesville, FL 32606-6669

EXAMINER

GUPTA, ANISH

ART UNIT PAPER NUMBER

1654

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,945

Applicant(s)

SEBTI ET AL.

Examiner

Anish Gupta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicants election, dated 1-7-04, is acknowledge. Applicants properly elected the species GDGY. However, the previous restriction has been amended as reflected below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 and 15-17, drawn to growth factor binding compounds, classified in class 530, subclass 330.
- II. Claims 7-8, drawn to method of treating diseases having cellular proliferation, angiogenesis, tumor, classified in class 514, subclass 18.
- III. Claims 9-11, drawn to method of measuring amount of growth factor in a sample, classified in class 436, subclass 501.
- IV. Claim 12, drawn to a method for delayed release of growth factor in a patient, classified in class 514, subclass 18.
- V. Claims 13-14, drawn to method for treating restenosis, classified in class 514, subclass 18.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Groups II-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of Group I can be practice using a materially different compounds such as sulfamide-metalloprotease inhibitors or Dioxocyclopentyl hydroxamic

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acids. The method of Group V can be practiced using materially different product such as 2-(3,4-dimethoxycinnamoyl)aminobenzoic acid. The method of Group III could be practiced with a materially different compound such as using growth factor receptors which are structurally distinct from compounds of claim 1. Using a materially different product such as liposome-encased growth factors can practice the method of Group IV.

The methods of Group II-V are materially different from one another in that they all involve materially different steps. For example, the method of Group II does not involve the same subject as the method of Group V. Further, the end responses for each methods are different. The methods of Group II, IV and V differ from method of Group III because the method of Group III is a assay that involves in-vitro methodology. The methods of Group II and V are treatment methods that seek specific outcomes in a patient. Group IV also involves in-vivo method with the end point being the release of the growth factor in a patient. Finally, the method Group IV and Group II and III differ in that the method of Group IV involves the use of a growth factor to achieve the desired result. Group II and V only involve the administration of a growth factor binding compound and does not need the presence of a Growth Factor.

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Claims 1-17 are drawn to growth factors that have attached to a cyclic complex tetrapeptides. The tetrapeptides are chosen from SEQ ID NO. 1-14. These tetrapeptides are structurally distinct from one another.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Currently, 1-17 generic. As stated earlier, Applicants properly elected a species GDGY. Applicants maintain the election of this species or elect a entirely different species. Whatever species Applicants elect, will be examined for the Group Applicants elect. Thus, if Applicants elect Group I, the elected species will be examined for Group I.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

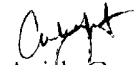
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (571)272-0965. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can normally be reached on (571) 272-0961. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Anish Gupta
Patent Examiner
April 27, 2004